

**REMARKS**

Claims 1-17 and 21-25 are all the claims pending in the application.

Claims 17 and 21 are amended to more clearly set forth the claimed subject matter, and claims 22-23 are amended to enlarge the chemical formulations recited in the claims.

Accordingly, no new matters has been introduced by these amendments to claims.

**I. Preliminary Matters**

In response to Applicants' previous remark regarding the compliance of the IDS filed on September 12, 2006, the Examiner neither has returned a fully initialed copy of PTO Form-892 filed on September 12, 2006 nor has responded to Applicants' previous request to do so in Applicants' Amendment filed on November 17, 2008.

Accordingly, Applicants respectfully request again that the Examiner return a fully initialed copy of PTO Form-892 filed on September 12, 2006.

**II. Claim 21 Complies With 35 U.S.C. § 112**

Claim 21 is rejected under 35 U.S.C. § 112 for allegedly failing to comply with the written description requirements. The Examiner states that the term, "an oncogene" is not fully described in the present specification.

Without agreeing with Examiner, solely to expedite the prosecution, Applicants have amended claim 21 to delete the term, "an oncogene," from claim 21.

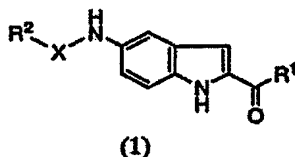
Accordingly, Applicants respectfully request that this rejection under 35 U.S.C. § 112 be reconsidered and withdrawn.

### III. Present Claims Are Patentable over Szekely and Sasaki

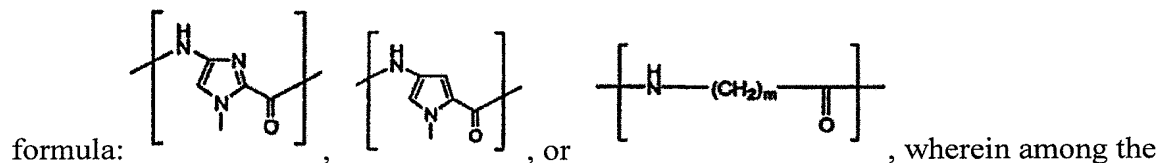
1. Claims 1-2, 14-15, 17, 21-23, and 25 are rejected under 35 U.S.C. 102 (b) as allegedly being anticipated by Szekely *et al.* (WO2003/072058, corresponding to US20050096261; "Szekely").

Applicants respectfully traverse as follows.

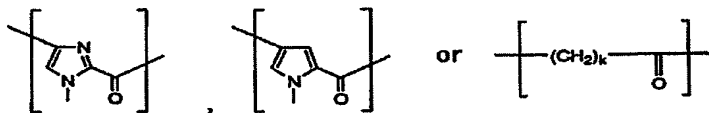
As pointed out in M.P.E.P. § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Applicants respectfully assert that the Office Action failed to provide a prior art reference that teaches every element as set forth in the amended claim.



Claim 1 recites formula (1), , wherein R<sup>1</sup> represents a  
functional group for alkylating DNA; R<sup>2</sup> represents a hydrogen atom, an alkyl group, or an acyl group; and X represents a divalent group having two or more constitutional units which may be the same or different, the constitutional unit being represented by the following



constitutional units, a terminal constitutional unit adjacent to R<sup>2</sup> may be a constitutional unit



Applicants respectfully assert that Szekely fails to disclose any formula (1) as set forth in independent claim 1. Specifically, Szekely fails to teach “R<sup>2</sup>” of formula (1) of claim 1, which is a hydrogen atom, an alkyl group, or an acyl group.

R2-X-Nc1ccc2c(c1)c(c[nH]2)C(=O)R

, wherein  $R^1$

$$\left[ \text{NH} - \text{C}_4\text{H}_3\text{N} - \text{C}(=\text{O}) - \right] \quad \left[ \text{NH} - (\text{CH}_2)_m - \text{C}(=\text{O}) - \right]$$

and  $\begin{bmatrix} 1 & 0 \\ 0 & 0 \end{bmatrix}$ , as shown

Diagram I

Szekely's formula (VI) at paragraph [0062]

The diagram shows a complex chemical structure composed of several interconnected fragments. On the left, a fragment labeled  $R^1$  is enclosed in a box. This fragment consists of a dimethylamino group connected via a methylene chain to a carbonyl group, which is linked to a series of three imidazole rings connected by amide bonds. The third imidazole ring is attached to a naphthalene-1-carboxamide moiety, which has a 2-chloroethyl substituent on the nitrogen. To the right of this is a fragment labeled  $X$ , also boxed, which is a 1-methyl-1H-imidazole-2-carboxamide group. Further to the right is a large, unlabeled fragment enclosed in a box. This fragment features a 1-methyl-1H-imidazole-2-carboxamide group connected to a benzene ring, which is further connected to a chain of three dimethylamino groups. The final part of this chain is connected to a naphthalene-1-carboxamide moiety, which has a 2-cyanoethyl substituent on the nitrogen.

Diagram I  
Szekely's formula (VI) at paragraph [0062]

However, as shown above, formula (VI) of Szekely fails to teach  $R^2$  as hydrogen, an alkyl or acyl group.

For the reasons set forth above, Applicants respectfully submit that Szekely fails to disclose any formula (1) as set forth in independent claim 1. Accordingly, Applicants request that the above rejection under 35 U.S.C. § 102 be reconsidered and withdrawn.

2. Claims 1-3, 5, 8, 14-17, and 21-25 are rejected under 35 U.S.C. 102(a) as allegedly being anticipated by Sasaki *et al.* (*Nucleic Acids Symposium Series, No. 48, pp. 205-206*, published in Nov. 2004).

In response, Applicants submit hereinwith a sworn translation of a certified copy of the priority document, Japanese Patent Application No. 2004-114793 filed. The filing date of Japanese Patent Application No. 2004-114793, March 13, 2004, is prior to Sasaki's publication date of November, 2004.

Support for the present claims can be found throughout the sworn translation of the priority document, especially in paragraphs [0008]-[0012] and the claims.

Accordingly, withdrawal of the above anticipation rejection under 35 U.S.C. § 102(a) is respectfully requested.

3. Claims 1-17, and 21-25 are rejected under 35 U.S.C. 103 (a) as allegedly unpatentable over Sasaki in view of Szekely.

As discussed above, Applicants submit hereinwith a sworn translation of a certified copy of the priority document, Japanese Patent Application No. 2004-114793 filed, and thus the Sasaki reference is removed as a 102(a) reference. Moreover, Szekely fails to teach or suggest any formula (1) as set forth in independent claim 1.

To establish a *prima facie* case obviousness the cited references must disclose all of the claim limitations. *In re Royka*, 490 F.2d 981, 984 (CCPA 1974). Applicant asserts that Szekely alone does not teach or suggest all the claim limitations of the invention, either explicitly or inherently for the reasons set forth above.

Accordingly, withdrawal of the above obviousness rejection under 35 U.S.C. § 103 is respectfully requested.

#### **IV. Claim Objections**

New claims 22-23 are objected to because the formulae in claims 22 and 23 are not clear.

In response, Applicants have enlarged the formulae in claims 22 and 23.

Accordingly, Applicants respectfully request that the objections of claims 22-23 be reconsidered and withdrawn.

**V. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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CUSTOMER NUMBER

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